

REMARKS

I. General

Claims 1-36 were pending in the present application. The current Office Action (mailed November 17, 2005) rejects claims 1-6, 8-20, 22-25, and 27-36, and objects to claims 7, 21, and 26 indicating that these claims would be allowable if rewritten in independent form. The current Office Action raises the following issues:

- Claims 10-19 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter;
- Claims 1, 3-6, 8-10, 14-18, 23, 25, and 27-34 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,686,914 issued to Keener (hereinafter “*Keener*”); and
- Claims 1-5, 8-16, 18, 20, 22-24, 27-33, and 35-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over published U.S. Patent application No. 2004/0098689 to Weed (hereinafter “*Weed*”).

In response, Applicant respectfully traverses the outstanding claim rejections, and requests reconsideration and withdrawal thereof in light of the amendments and remarks presented herein.

II. Amendments

Claims 1, 7, 10, 19, 20, 23, 26, 28, and 36 are amended and claims 6, 17, 18, 21, 25, 27, 34, and 35 are canceled without prejudice herein. No new matter is added by these amendments.

Independent claim 1 is amended herein to recite “wherein the data file includes the design parameters in a CAD-independent format”, as was originally recited in claim 6, which depended indirectly from claim 1. Thus, claim 6 is canceled without prejudice. Claim 1 is further amended to recite “modifying said design parameters in said data file”, and to specify that the recited computer-executable program accesses the “modified” data file and populates the CAD program’s database with the “modified” design parameters.

Claim 7 is rewritten herein in independent form. This amendment to claim 7 is not intended to narrow its scope in any way whatsoever. Because the Office Action asserts that claim 7 would be allowable if rewritten in independent form, Applicant respectfully submits that claim 7 is now allowable.

Claim 10 is amended to recite that the parameter entry program and CAD program are stored to computer-readable media, thereby ensuring that the claim falls within well-recognized statutory subject matter under 35 U.S.C. §101. Claim 10 is also amended to recite “wherein the data file is in a CAD-independent format and is editable by an interface”, as was originally recited in claims 17 and 18, which depended from claim 10. Thus, claims 17 and 18 are canceled without prejudice.

Claim 19 is rewritten herein in independent form. This amendment to claim 19 is not intended to narrow its scope in any way whatsoever. As with claim 10 above, claim 19 is also amended to recite that the parameter entry program and CAD program are stored to computer-readable media, thereby ensuring that the claim falls within well-recognized statutory subject matter under 35 U.S.C. §101. Just as claims 7, 21, and 26 are indicated by the Office Action as being allowable if rewritten in independent form, Applicant respectfully submits that claim 19 should likewise be allowable.

Claim 20 is amended to include the element of claim 21, thereby effectively rewriting claim 21 in independent form as claim 20. This amendment is not intended to narrow the scope of claim 20 beyond the original scope of claim 21 in any way whatsoever. Because the Office Action asserts that claim 21 would be allowable if rewritten in independent form, Applicant respectfully submits that claim 20 (which rewrites claim 21 in independent form) is now allowable. Claim 21 is canceled without prejudice.

Claim 23 is amended to recite “wherein the data file includes said at least a portion of the parameters in a CAD-independent format”, as was originally recited in claim 25, which depended from claim 23. Thus, claim 25 is canceled without prejudice. Claim 23 is further amended to recite the elements originally presented in claim 27, which depended from claim 23. Thus, claim 27 is also canceled without prejudice.

Claim 26 is rewritten herein in independent form. This amendment to claim 26 is not intended to narrow its scope in any way whatsoever. Because the Office Action asserts that claim 26 would be allowable if rewritten in independent form, Applicant respectfully submits that claim 26 is now allowable.

Claim 28 is amended to recite that the data file is in CAD-independent format, as was originally recited in claim 34, which depended from claim 28. Thus, claim 34 is canceled without prejudice. Claim 28 is further amended to include the element originally presented in claim 35, which depended from claim 28. Thus, claim 35 is also canceled without prejudice. Because claim 35 is canceled, claim 36 is amended to depend from claim 28, rather than from claim 35. Claim 36 is also amended to correct an informality by reciting “the” before “file editing program” for improved clarity. The amendments to claim 36 are not intended to narrow its scope in any way.

III. The Office Action is Incomplete

The Office Action is incomplete because it fails to address claim 19. While the Office Action Summary indicates that claim 19 is rejected, no mention of claim 19 or an explanation of the grounds on which such claim is rejected is provided in the Office Action. M.P.E.P. § 707.07(d) provides that where “a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated” (emphasis added). Thus, because the ground of rejection of claim 19 has not been provided in the Office Action, Applicant has not been afforded a full and fair opportunity to address such rejection. Accordingly, Applicant respectfully asserts that a new, non-final Office Action should be issued that addresses the ground of rejection of claim 19 or that indicates allowance thereof.

IV. Rejections Under 35 U.S.C. §101

Claims 10-19 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Without conceding that the rejection is proper, claim 10 is amended herein to recite that the parameter entry program and CAD program are stored to computer-readable media, thereby ensuring that the claim falls within well-recognized statutory subject matter under 35 U.S.C. §101. Thus, Applicant respectfully requests that the rejection of claims 10-19 be withdrawn.

V. Rejections Under 35 U.S.C. §103

Claims 1, 3-6, 8-10, 14-18, 23, 25, and 27-34 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Keener*. Also, claims 1-5, 8-16, 18, 20, 22-24, 27-33, and 35-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Weed*. Appellant respectfully traverses these rejections, as discussed below.

To establish a prima facie case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the applied references must teach or suggest all the claim limitations. Without conceding the second criteria, Applicant respectfully asserts that the rejections do not satisfy at least the third criteria. That is, neither *Keener* nor *Weed* teaches or suggests all elements of independent claims 1, 10, 23, or 28, as discussed below.

Independent Claim 1

Claim 1, as amended herein, recites:

A method comprising:
generating a data file having design parameters for an electrical design,
wherein the data file includes the design parameters in a CAD-independent
format;
modifying said design parameters in said data file; and
with a computer-executable program, accessing the modified data file
and populating a computer-aided design (CAD) program's database with the
modified design parameters. (Emphasis added).

Neither *Keener* nor *Weed* teaches or suggests the above-emphasized elements of claim 1. *Keener* mentions translating an original CAD model to a neutral file format and then translating the neutral file format to a format of a secondary CAD system. For instance, *Keener* provides at col. 2, lines 6-27:

Because of the many different CAD systems available, secondary users will often be using a CAD system that varies significantly from the one originally employed by the primary user to design the part or assembly. When this occurs, the original CAD model should be translated from the primary

user's "primary" CAD system to the secondary user's "secondary" CAD system so the secondary user can utilize the model as intended. For example, if the primary user utilized the Unigraphics CAD system to create a part or assembly model, and the secondary user is utilizing the AutoCAD system, then the CAD model should be translated from the Unigraphics format to the AutoCAD format before it is used by the secondary user.

To translate a CAD model from a primary CAD system (e.g., Unigraphics) to a secondary CAD system (e.g., AutoCAD), the CAD model may be first translated into a neutral file format. A neutral file format (e.g., STEP, IGES, DXF, etc.) is a file format which can be used to transfer geometric data between two different CAD systems. Once transferred, the CAD model in the neutral file format can be read directly into the secondary CAD system to create a CAD model in the secondary CAD system format.

While *Keener* mentions that a CAD model may be translated to a neutral file format, *Keener* does not teach or suggest modifying the design parameters in such neutral file format. Instead, the neutral file format is merely translated into another format for reading the original CAD model by a secondary CAD system in *Keener*.

Similarly, *Weed* provides no teaching or suggestion of this element of claim 1. Thus, Applicant respectfully submits that claim 1, as amended herein, is of patentable merit over the applied references of record.

Independent Claim 10

Claim 10, as amended herein, recites:

A system comprising:
a database;
a parameter entry program stored to computer-readable media and operable to access a data file and populate the database with design parameters included in the data file for an electrical design, wherein the data file is in a CAD-independent format and is editable by an interface; and
a computer-aided design (CAD) program stored to computer-readable media, wherein the CAD program is operable to communicatively access the database and retrieve the design parameters stored therein. (Emphasis added).

Neither *Keener* nor *Weed* teaches or suggests the above-emphasized elements of claim 10. As described above with claim 1, *Keener* mentions translating an original CAD model to a neutral file format and then translating the neutral file format to a format of a

secondary CAD system, *see* col. 2, lines 6-27 of *Keener*. However, while *Keener* mentions that a CAD model may be translated to a neutral file format, *Keener* does not teach or suggest that the neutral file is editable by an interface. Instead, the neutral file format is merely translated into another format for reading the original CAD model by a secondary CAD system in *Keener*.

Similarly, *Weed* provides no teaching or suggestion of this element of claim 10. Thus, Applicant respectfully submits that claim 10, as amended herein, is of patentable merit over the applied references of record.

Independent Claim 23

Claim 23, as amended herein, recites:

A method comprising:
interacting with an interface of a computer-aided design (CAD)
program for defining parameters for an electrical design;
storing, by said CAD program, the parameters to a database for use in
representing the electrical design; ~~and~~
retrieving, by a parameter entry program, the parameters from the
database and generating a data file having at least a portion of the parameters
for said electrical design, wherein the data file includes said at least a portion
of the parameters in a CAD-independent format;
editing the parameters in the data file; and
with a computer-executable program, accessing the data file and
populating the database with the edited parameters of the data file. (Emphasis
added).

Neither *Keener* nor *Weed* teaches or suggests the above-emphasized elements of claim 23. As described above with claim 1, *Keener* mentions translating an original CAD model to a neutral file format and then translating the neutral file format to a format of a secondary CAD system, *see* col. 2, lines 6-27 of *Keener*. However, while *Keener* mentions that a CAD model may be translated to a neutral file format, *Keener* does not teach or suggest editing parameters in such a neutral file. Instead, the neutral file format is merely translated into another format for reading the original CAD model by a secondary CAD system in *Keener*.

Similarly, *Weed* provides no teaching or suggestion of this element of claim 23. Thus, Applicant respectfully submits that claim 23, as amended herein, is of patentable merit over the applied references of record.

Independent Claim 28

Claim 28, as amended herein, recites:

A computer comprising:
a data storage mechanism having software code for a parameter entry program stored thereto; and
at least one processor for executing said software code to access a data file that is in CAD-independent format and populate a database with design parameters included in the data file for an electrical design, wherein said database is communicatively accessible by a computer-aided design (CAD) program for retrieving the design parameters stored in the database; and
a data storage mechanism having software code for a file editing program stored thereto, wherein the file editing program is executable by the at least one processor to provide an interface for enabling a user to edit the data file. (Emphasis added).

Neither *Keener* nor *Weed* teaches or suggests the above-emphasized elements of claim 28. As described above with claim 1, *Keener* mentions translating an original CAD model to a neutral file format and then translating the neutral file format to a format of a secondary CAD system, *see* col. 2, lines 6-27 of *Keener*. However, while *Keener* mentions that a CAD model may be translated to a neutral file format, *Keener* does not teach or suggest a file editing program that provides an interface for enabling a user to edit such neutral file. Instead, the neutral file format is merely translated into another format for reading the original CAD model by a secondary CAD system in *Keener*.

Similarly, *Weed* provides no teaching or suggestion of this element of claim 28. Thus, Applicant respectfully submits that claim 28, as amended herein, is of patentable merit over the applied references of record.

Dependent Claims 2-5, 8-9, 11-16, 24, 29-33, and 36

Each of dependent claims 2-5, 8-9, 11-16, 24, 29-33, and 36 depend either directly or indirectly from one of independent claims 1, 10, 23, and 28, and thus inherit all limitations of

the respective independent claim from which they depend. It is respectfully submitted that dependent claims 32, 36, 39, 42, 45, and 49 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

VI. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 200209358-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 568257462US in an envelope addressed to: M/S Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: January 24, 2006

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